



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,534	08/08/2001	Robert Noodelijk	CHRE:118	2112

7590 08/25/2003

PARKHURST & WENDEL
SUITE 210
1421 PRINCE STREET
ALEXANDRIA, VA 22314

EXAMINER

GRUNBERG, ANNE MARIE

ART UNIT	PAPER NUMBER
----------	--------------

1661

DATE MAILED: 08/25/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,534

Applicant(s)

NOODELIJK, ROBERT

Examiner

Anne Marie Grunberg

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

1. Claim 1 remains rejected under 35 U.S.C. 102(b) as being clearly anticipated by Plant Breeder's Right Application number NL PBR CHR3164 in view of Applicant's admission that 'Etna' was first offered for sale in December 1999 for the reasons stated in the previous action.

Response to Arguments

Applicant's arguments filed 6/03/03 have been fully considered but they are not persuasive for the following reasons:

Applicant argues that 35 U.S.C. 102(b) specifically refers to acts inside the U.S. and not elsewhere. Applicant further argues that it is improper to combine an admittedly non-enabling publication with sales abroad and conclude that the subject matter is barred under 102(b).

Furthermore, Applicant argues that *Ex parte Thomson* involved a utility patent with sexually propagated seeds and an inherently broader scope of protection. Finally, Applicant argues that a Plant Breeders' Right (PBR) does not contain enough detail to be enabling.

The rejection made under 102(b) is based on a publication. The pertinent part of the statute reads, "(b) the invention was... described in a printed publication in this or a foreign country... more than one year prior to the date of application for patent in the United States. As a result, it is very clear that the publication may be printed in a foreign country.

In *In re LeGrice*, the court held that in order for a printed publication to be a statutory bar under 35 U.S.C. 102(b), the publication must provide an enabling disclosure. In the words of the court,

“Before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention*.” 133 USPQ at 372 (emphasis in original).

The court then states that plant publications should not be totally ignored as printed publications; rather the fact that a printed publication must be enabling “requires that the facts of each case be carefully considered to determine whether the description in a printed publication in question *does in fact* place the invention in the possession of the public” 133 USPQ at 374.

In summarizing the long recognized requirements of a prior publication, the court quotes Robinson on Patents, Sec. 325 as follows:

[To have the effect of a prior publication,] the publication must be: (1) A work of public character, intended for general use; 2) Within reach of the public; (3) Published before the date of the later invention; (4) A description of the same complete and operative art or instrument; and (5) So precise and particular that any person skilled in the art to which the invention belongs can construct and operate it without experiments and without further exercise of inventive skill. Unless a publication possesses all these characteristics it does not place the invention in possession of the public. 133 USPQ at 369.

The PBR document that is relied upon by the Examiner is a publication that meets each of these criteria. The application of Plant Breeders' Rights is publicly available. The cited PBR was published more than a year prior to filing in the United States. The citation is drawn to the same plant for which patent was filed. Lastly, the PBR document precisely refers to the species of plant and the name of the plant. Since this plant was sold more than one year prior to the effective filing date of the present application, one skilled in the art would have been able to

Art Unit: 1661

purchase and propagate the plant without experiment or further inventive skill. By using the referenced publication, one of skill in the art would have been able to contact the Applicant, Breeder, and Title Holder of the plant in question and subsequently obtain a plant since it was being marketed by Applicant's own admission. Such a plant would have been in the public possession due to information in the publication. The PBR publication when considered in combination with the knowledge of one skilled in the art, i.e., the availability of the plant in the public domain as evidenced by sale of the claimed plant more than one year prior to application for patent, is enabled.

In attempting to distinguish the present case from *Ex parte Thomson*, Applicant states that *Ex parte Thomson* was a utility application having a broader scope of protection and the propagule was a sexually reproduced seed. This however has no bearing on the instant case. *In re LeGrice* as well as 35 U.S.C. 161 and 37 CFR 1.161 clearly state that the same laws and rules relating to applications for utility patents are also applicable to patents for plants except for the one exception set forth in 35 USC 162. As a result, the standard for anticipation in a plant patent is the same as the standard for anticipation in a utility patent.

Applicant states that the PBR does not contain enough detail to be enabling. However, no amount of detail will make a plant publication enabling unless the plant was publicly available. The fact remains that the PBR is drawn to the same plant as is claimed in the present application.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

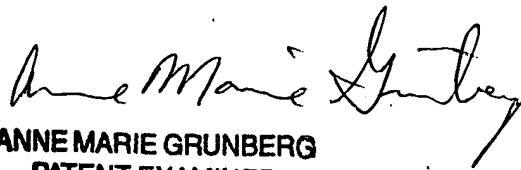
Art Unit: 1661

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie Grünberg whose telephone number is (703) 305-0805. The examiner can normally be reached on Mon-Thur, 7:00 am to 4:30 pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (703) 308-4205. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


ANNE MARIE GRUNBERG
PATENT EXAMINER